

Serial No.: 10/758,386  
RCE to FOA of 03/24/2006

### Remarks

In the present RCE, five claims (1, 3, 5, 7, and 14) are amended. Claims 1-20 are presented for examination.

#### I. Claims Rejections: 35 USC § 112

Claims 1 and 3 are rejected under 35 USC § 112, first paragraph, as failing to comply with the enablement requirement. Claims 1 and 3 are amended, and this rejection is moot. Support for the amendments is found at least in paragraph [0024] and FIG. 3.

Applicants respectfully request withdrawal of these rejections.

#### II. Claims Rejections: 35 USC § 102(b)

Claims 1-4 are rejected under 35 USC § 102(b) as being anticipated by USPN 6,863,554 (Glad). Applicants respectfully traverse.

A proper rejection of a claim under 35 U.S.C. §102 requires that a single prior art reference disclose each element of the claim. See MPEP § 2131, also, *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983). Since Glad neither teaches nor suggests each element in claims 1-4, these claims are allowable over Glad.

Independent claims 1 and 3 recite numerous recitations that are not taught or suggested in Glad. By way of example, independent claim 1 recites a computer system having a sidewall with an aperture and a multiple-connector apparatus that passes at least partially through an aperture. When the multiple-connector apparatus is in a retracted position, "only an outer face of the multiple-connector apparatus is exposed through the aperture." Glad does not teach or suggest these recitations.

As shown in FIG. 1 of Glad, the modem card 118 protrudes outwardly from a sidewall of the lap top 8. Further, as shown in FIGS. 6 and 7 of Glad, the receptacle module 115 protrudes outwardly from a sidewall of the communication card 150. "In order to use the apparatus, a user preferably grasps finger grips 166 and pulls the body 166 out to an extended position as represented in FIG. 7" (11: 13-15). Thus, in Glad, more than an outer face of the receptacle module is exposed through an aperture when the receptacle module is in the retracted position.

Serial No.: 10/758,386  
RCE to FOA of 03/24/2006

For at least these reasons, independent claims 1 and 3 and their dependent claims are allowable over Glad.

### **III. Claims Rejections: 35 USC § 103(a)**

Claims 5-20 are rejected under 35 USC § 103(a) as being unpatentable over Glad in view of USPN 6,093,038 (Chen). Applicants respectfully traverse.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. *See* M.P.E.P. § 2143. Applicants assert that the rejection does not satisfy these criteria. Without conceding whether the second criterion has been met, Applicants discuss the first and third criteria to demonstrate that a prima facie case of obviousness does not exist.

#### **No Suggestion/Motivation to Combine/Modify References**

For at least the following reasons, no suggestion or motivation exists to combine and/or modify Glad in view of Chen. Glad actually **teaches away** from Chen. The specification in Glad repeatedly states that the receptacle module is removable (for numerous examples, see Glad at 11: 8-46: "The removable receptacle module 151 is advantageously easily removable from the communications card 150."). Glad stresses the importance of having a receptacle module and card that are removable:

It is common for a receptacle module, such as receptacle module 100, to be broken or damaged during use. If a receptacle module, or other structure providing connection to a communications line is permanently affixed to the communications card or its equivalent, then the only practical recourse is replacement of the entire communications card, even though only the receptacle module has been damaged. The embodiment of the

Serial No.: 10/758,386  
RCE to FOA of 03/24/2006

present invention represented in FIGS. 6-9 provides that the receptacle module can be easily replaced in case of damage. (Glad at 11: 28-37).

In direct contrast to Glad, Chen teaches an interface connector that is not removable from a notebook computer. For example, FIG. 5 in Chen shows connector board 10 connected to a main board 202 via soft wires 30 (see Chen at 2: 41-46).

A reference that teaches away may not be properly used in framing a 35 USC 103 rejection of the claims (see *United States v. Adams*, 148 USPQ 429 (Sup. Ct. 1966)). The MPEP also reinforces this legal position: "It is improper to combine references where the references teach away from their combination" (see MPEP 2145 X.D.2).

For at least these reasons, Applicants respectfully argue that a prima facie case of obviousness has not been established.

#### **All Elements Not Taught or Suggested**

Claims 5-20 recite numerous recitations that are not taught or suggested in Glad in view of Chen. Examples are provided for the independent claims.

Independent claim 5 recites that the changing means "is mounted inside the housing and not fully detachable from the housing means." Independent claim 7 recites that the connector tray "is mounted inside the housing and not removable from the housing." Independent claim 14 recites that the multiple-connector "is mounted inside an aperture of the computer system and not detachable from the computer system." Glad in view of Chen does not teach or suggest at least these recitations.

As shown in FIG. 1 of Glad, the receptacle module 100 is removable from the modem card 118. Further, the specification in Glad repeatedly states that the receptacle module is removable (for numerous examples, see 11: 8-46). Chen teaches an interface connector that pivotally connects "on the case" of the notebook computer (see Chen at 2: 29-31). Thus, Chen does not teach or suggest a changing means or multiple-connector "mounted inside the housing."

For at least these reasons, independent claims 5, 7, and 14 and their dependent claims are allowable over Glad in view of Chen.

Serial No.: 10/758,386  
RCE to FOA of 03/24/2006

As one example, independent claim 8 recites “a connector tray having first and second portions pivotably connected together.” Glad in view of Chen does not teach or suggest these recitations.

The Office Action cites elements 154 and 186 in Glad for allegedly teaching these claim recitations. First, elements 154 and 186 appear in two separate and different embodiments in Glad. Applicants respectfully request clarification. Second, element 154 in Glad is a recess in the receptacle module (see 11: 47-53). Element 154 is not a pivotal member.

For at least these reasons, independent claim 8 and its dependent claims are allowable over Glad in view of Chen.

As another example, independent claim 8 recites the following recitations:

an extension/retraction mechanism that locks the first and second portions in a retracted position until released therefrom and enables the released first and second portions to extend to **an extended position at which the second portion can pivot relative to the first portion** (emphasis added).

Glad in view of Chen does not teach or suggest these recitations. The Office Action cites elements 151, 154, and 158 in Glad for allegedly teaching these recitations. Applicants respectfully disagree. Nowhere does Glad teach or suggest that the receptacle module 151 or communication card 150 (see FIGS. 6 and 7) can move to “an extended position at which the second portion can pivot relative to the first portion.”

For at least these additional reasons, independent claim 8 and its dependent claims are allowable over Glad in view of Chen.

Independent claim 11 recites a multiple-connector tray with a first portion and a second portion with at least one connector. The claim also recites “pivoting the second portion relative to the first portion to render the connector accessible.” Glad in view of Chen does not teach or suggest these recitations.

The Office Action cites element 154 in Glad for allegedly teaching the recitations regarding pivoting the second portion relative to the first portion to render the connector

Serial No.: 10/758,386  
RCE to FOA of 03/24/2006

accessible. Applicants strongly disagree. Element 154 in Glad is a recess in the receptacle module (see 11: 47-53). Nowhere does Glad teach or even suggest that its receptacle module has first and second portions that pivot as recited in claim 11.

For numerous reasons, Chen also does not teach or suggest the recitations of claim 11. In Chen, the interface connectors 101 are exposed and accessible when the connector board is in both the storage position (see FIG. 1) and the usage position (see FIG. 3). Thus, Chen does not teach or suggest at least the following two claim elements:

extending the multiple-connector tray to an extended position  
relative to the housing to expose the second portion; and  
pivoting the second portion relative to the first portion to  
render the connector accessible.

For at least these reasons, independent claim 11 and its dependent claims are allowable over Glad in view of Chen.

Serial No.: 10/758,386  
RCE to FOA of 03/24/2006

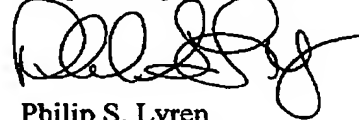
### CONCLUSION

In view of the above, Applicants believe that all pending claims are in condition for allowance. Allowance of these claims is respectfully requested.

Any inquiry regarding this Amendment and Response should be directed to Philip S. Lyren at Telephone No. (832) 236-5529. In addition, all correspondence should continue to be directed to the following address:

**Hewlett-Packard Company**  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, Colorado 80527-2400

Respectfully submitted,



Philip S. Lyren  
Reg. No. 40,709  
Ph: 832-236-5529

#### CERTIFICATE UNDER 37 C.F.R. 1.8

The undersigned hereby certifies that this paper or papers, as described herein, is being transmitted to the United States Patent and Trademark Office facsimile number 571-273-8300 on this 20th day of June, 2006.

By   
Name: Carrie McKerley

THIS PAGE INTENTIONALLY LEFT BLANK